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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/039,842

10/26/2001

Brian V. Mech

S121-USA

8947

28284

7590

07/14/2004

SECOND SIGHT, LLC
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EXAMINER

BOCKELMAN, MARK

ART UNIT

PAPER NUMBER

3762

6

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/039,842

Applicant(s)

Mech et al *cn*

Examiner

Mark W Bockelman

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 12-2-02.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27 and 28 is/are allowed.
- 6) ☒ Claim(s) 1-26 and 29-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2,3</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3762

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 33-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is unclear where in the applicant's original specification support can be found for the capacitor type device with diamond separating layer can be found. The examiner requests applicants to point out where they consider support to be found.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in

Art Unit: 3762

the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 29-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Nilsson et al USPN 6,162,219 Nilsson teach electrodes that are coated with an insulating diamond coating column 6 lines 50-60,

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 33, 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nilsson USPN 6162,219 in view of Lindegren et al USPN 5,445,859

Nilsson teaches an electrode coated with a diamond coating but does not teach a second electrode that is capable of forming a capacitor with the first electrode. Lindegren shows it was well known to include a second lead so as to provide a multipolar lead. To have modified Spehr to include a second electrode would have been well known and obvious as evidenced by Lindegren.

Claims 1-3, 5, 10-24 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable

Art Unit: 3762

over Nilsson USPN 6162,219 in view of Gruen et al USPN 5,772,760. Nilsson teaches a diamond coated electrode wire that includes a shank portion as well as a coiled portion (40). Applicant differs in reciting that the diamond film is an ultrananocrystalline structure. Gruen et al teaches a method of forming diamond thin films in the form of nanocrystalline form which applicant recognizes as inherently forming hermetic seals and which process they themselves use (see page 7 of the application). Gruen teaches similar properties such as electrical resistanceness. To have provide the diamond coating of Nilsson by a method as taught by Gruen et al would have been an obvious for the benefits stated by Gruen et al.

Claims 1-3, 5-13, 15-26, 29-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato USPN 5,432,357 in view of Gruen et al. USPN 5,772,760. Kato teaches a device with a protective package which includes electrodes²³ that has an undoped (insulative) diamond portion 22 and a doped semi-conducting diamond portion 24. Applicant differs in reciting an nanocrystalline diamond coating. Gruen teaches method for coating devices with diamond that is a nanocrystalline coating with various properties useful for coating electronic circuits. To have use the Gruen techniques for coating the Kato diamond portions would have been obvious for the benefits taught by Gruen et al.

Claims 1-26, 29-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Art Unit: 3762

Michael USPN 5,825,078 in view of Gruen et al USPN 5,772,760. Michael teach the use of diamond like coatings to hermetically seal electronic circuits Gruen et al teach nanocrystalline coatings that have have chemical inertness as well as other properties that are the same as desired by Michael. To have substituted the coatings of Gruen for those of Michael would have been obvious to hermetically seal the electronic circuits. Applicant's claims merely recite well known circuit components which one of ordinary skill in the art would recognize as one being covered by the teachings of Michael.

Allowable Subject Matter

Claims 27-28 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark W Bockelman whose telephone number is (703)-308-2112. The examiner can normally be reached on Monday - Thursday 10-8:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (703) 308-5181. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3762

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 13, 2004

MWB


MARK BOCKELMAN
PRIMARY EXAMINER